

REMARKS

1. Response to rejection of claims 6, 7, 9, 12, and 19 under 35 U.S.C. § 112

Applicants respectfully request reconsideration of the rejection of claims 6, 7, 9, 12, and 19 under 35 U.S.C. § 112, first paragraph, as lack of disclosure on how one skilled in the art could arrange the magnets in one plane. Applicants respectfully call attention to Figs. 47-50, and to paragraph [0139] which discusses a “fourth embodiment of an inventive open field magnetic surgery system constructed according to the principles of this invention.” The principles of the invention include a method by which the size and location of the coils can be selected, provided in paragraphs [0098] – [0115].

According to paragraph [0100], the method may include making initial assumptions about the coils that will be used. One skilled in the art would consider the location of the magnets in substantially the same plane, as an initial assumption.

Paragraph [0102] provides considerations for an additional step, determining a trial coil size, that may be included in the method. “The dimensional details of the imaging equipment and beams, of the trial coil sizes and shapes, of the patient and the bed, etc., are put into a three-dimensional CAD program for interactive decision-making magnetic field determinations.”

Paragraph [0104] goes on to explain that “[a]n exact determination of the coil sizes and locations is achieved by iterative computer modeling in conjunction with the CAD plots.” Finally, paragraph [0106] provides, “[g]iven a target field strength requirement, it can be determined, from the iterative computer modeling or by some other method,

whether the individual coils have sufficient strength to cover, or nearly cover, the operating region.”

Thus without undue or unreasonable experimentation, one skilled in the art could use this method to arrange and configure magnets substantially in a plane to provide a magnetic field effective within the operating region to navigate the magnetic medical device within the operating region. The applicants respectfully submit that the rejection of claims 6, 7, 9, 12, and 19, first paragraph, as lack of disclosure on how one skilled in the art could arrange the magnets in one plane should be withdrawn.

2. Response to rejection of claims 3-20 under 35 U.S.C. § 103(a)

Applicants respectfully request reconsideration of the rejection of claims 3-20 under 35 U.S.C. §103(a) as obvious from Werp et al.

Werp discloses a magnetic surgery system requiring six coils which operate in unbalanced pairs acting as three vectors having mutually perpendicular directions, but different magnitudes. (figure 2; column 5, lines 32-41). Each of the six coils lies in a separate plane. In contrast, claim 3, and thus claims 4 and 5 depending therefrom, claim 7, and claim 9, of the present invention (referring to figures 47-50) require “at least three magnets configured and arranged in substantially the same plane.” Because Werp lacks any teaching or suggestion of a substantially planar configuration, it cannot make the claimed invention obvious.

The claimed configuration increases the accessibility to the patient during navigation. The decrease in the number of coils combined with the planar arrangement of the present invention dramatically increases the surgeon's access to the patient.

Likewise, claim 10 and thus claims 11, 13-15 depending therefrom, claim 16 and thus claims 17 and 18 depending therefrom, require "four electromagnets arranged substantially in a plane." As shown above, this arrangement is neither taught nor suggested in Werp et al. Additionally, the previously discussed improvements associated with the reduced number of coils and the planar arrangement were not taught or suggested.

Claim 12 and 19 require "four electromagnets arranged substantially in a generally vertical plane arranged in two rows of two." As shown above, this arrangement is neither taught nor suggested in Werp et al. Additionally, the previously discussed improvements associated with the reduced number of coils and the planar arrangement were not taught or suggested.

For at least these reasons, applicants respectfully submit that the rejection of claims 3-20 under 35 U.S.C. § 103(a) as being obvious from Werp et al. should be withdrawn.


CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7500.

Respectfully submitted,

Dated: 26 AUGUST 2004

By:


Bryan K. Wheelock, Reg. No. 31,441

HARNESS, DICKEY & PIERCE, P.L.C.
7700 Bonhomme, Suite 400
St. Louis, Missouri 63105
(314) 726-7500

G:\Stereotaxis, Inc- 5236\000227\Response to 3-26-04 OA.doc